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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHAWN E. WIEDERIN, RICHARD G. MOORE, DURAISAMY GUNASEKAR, GREGORY MUMFORD, LONNIE S. CLABAUGH, JON ABEL, and KOLIN G. HOGUE

Appeal 2009-007311
Application 09/836,589
Technology Center 3600

Decided:¹ June 11, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 STATEMENT OF THE CASE

2 Shawn E. Wiederin, Richard G. Moore, Duraisamy Gunasekar,
3 Gregory Mumford, Lonnie S. Clabaugh, Jon Abel, and Kolin G. Hogue
4 (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims
5 1-40, the only claims pending in the application on appeal.

6 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
7 (2002).

8
9 We REVERSE.

10 The Appellants invented a way to charge for directory assistance
11 services. This is done by tracking the number of directory listings that are
12 transmitted to and displayed on a client access device; and preparing billing
13 information based upon the number of directory listings (Specification 4:¶'s
14 [07]-[08]).

15 The Appellants' invention permits the customer to select the desired
16 information based upon viewing a portion of the information. The capability
17 to view the information partially allows the customer to retrieve accurate
18 data that is reflective of the customer's, and to pay for only those selected
19 directory listings that are actually used (i.e., accessed and viewed). In this
20 manner, the third party data provider is only compensated for the listings
21 that are accessed and viewed by the customer (Specification 15-16:¶ [46]).
22 Thus, the Appellants' invention selects multiple listings for display, each of
23 which has only partial information. The customer must select one or more
24 to view hidden information for each selected to find the entry desired. So
25 there is the additional step of selecting for more information beyond the
26 usual selecting for dialing in conventional directory assistance.

1 An understanding of the invention can be derived from a reading of
2 exemplary claim 1, which is reproduced below [bracketed matter and some
3 paragraphing added].

4 1. A method of charging for directory assistance services that
5 are provided over a packet switched network, the method
6 comprising:
7 [1] transmitting information associated with a plurality of
8 directory listings to a client access device over the packet
9 switched network in response to a query initiated by a
10 customer;
11 [2] in response to a selection of more than one of the directory
12 listings from the client access device, transmitting a plurality of
13 listing numbers to the client access device; and
14 [3] preparing billing information based upon a number of the
15 plurality of listing numbers transmitted to the client access
16 device.

17
18 This appeal arises from the Examiner's Final Rejection, mailed
19 November 30, 2006. The Appellants filed an Appeal Brief in support of the
20 appeal on June 20, 2007. An Examiner's Answer to the Appeal Brief was
21 mailed on November 13, 2008. A Reply Brief was filed on December 3,
22 2008.

23

24

PRIOR ART

25

The Examiner relies upon the following prior art:

26	Gerszberg	US 6,052,439	Apr. 18, 2000
27	Shah	US 6,212,506 B1	Apr. 3, 2001
28	Cox	US 2002/0115431 A1	Aug. 22, 2002

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Gale Group, *BOC Expands Directory Options*, 9 BOC Week (Jan. 1992) (hereinafter "Gale Group").

1 REJECTIONS

2 Claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 stand rejected under 35
3 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, and Gale Group.

4 Claims 2-4, 10-12, 18-20, 26-28, and 34-36 stand rejected under 35
5 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, Shah, and Gale
6 Group.²

7 ISSUES

8 The issue of whether the Appellants have sustained their burden of
9 showing that the Examiner erred in rejecting claims 1, 5-9, 13-17, 21-25, 29-
10 33, and 37-40 under 35 U.S.C. § 103(a) as unpatentable over Cox,
11 Gerszberg, and Gale Group hinges on whether the references describe or
12 show that it was predictable to select more than one directory listing from a
13 client access device and transmit a plurality of listing numbers to the client
14 access device in response.

15 The issue of whether the Appellants have sustained their burden of
16 showing that the Examiner erred in rejecting claims 2-4, 10-12, 18-20, 26-
17 28, and 34-36 under 35 U.S.C. § 103(a) as unpatentable over Cox,
18 Gerszberg, Shah, and Gale Group hinges on the first rejection.

² The statement of the statutory basis for this rejection omits Gale Group from the list of references upon which the rejection is based (Answer 7). That same statement of statutory basis states that the references are applied as they were in the first rejection, however, all of the claims in this rejection depend from claims in the prior rejection. Gale Group was one of the references applied in the prior rejection, and was therefore applied to all of the claims from which the claims in this rejection depend. Thus, we take the Examiner to have included Gale Group in this rejection as well, and its omission is simply a typographic error.

1

2 FACTS PERTINENT TO THE ISSUES

3 The following enumerated Findings of Fact (FF) are believed to be
4 supported by a preponderance of the evidence.

5 *Cox*

6 01. Cox is directed to the provision of directory assistance services
7 to cellular telephone subscribers (Cox ¶ 0001).

8 02. In prior art directory assistance services, a customer dials an
9 operator and identifies the name and address of a party whose
10 telephone number is desired. The operator then locates the
11 number, using printed directories or a computer database, and
12 provides the number to the customer (Cox ¶ 0003).

13 03. In the prior art, after determining the telephone number desired
14 by the customer, rather than voicing it to the customer, the
15 directory assistance operator may initiate a call to the desired
16 party (Cox ¶ 0005).

17 04. Cox, rather than dropping all further involvement with the call,
18 continually monitors the connection established for a
19 predetermined dual tone multi-frequency (DTMF) signal issued
20 by the customer, such as that obtained by pressing the "*" button.
21 If such a signal is detected, the customer is transferred back to a
22 directory assistance operator, who can then provide whatever
23 further assistance is needed (Cox ¶ 0007).

24 05. The directory assistance service logs, in a billing database,
25 information identifying the customer, the destination number to
26 which the customer is connected, and the date, time and duration

1 of the customer/destination number connection. This log of
2 information is periodically provided to the cellular carrier,
3 allowing it to bill the customer for the call connected by the
4 directory assistance operator and recoup the associated expense
5 (Cox ¶ 0008).

6 *Gale Group*

7 06. Gale Group is directed to describing how Southwestern Bell
8 was expanding the coverage for its multiple listing directory
9 assistance (Gal Group 1).

10 07. The technology allows customers to get more than the usual
11 two directory listings per call from directory assistance. In Texas,
12 beyond a customer's monthly free-call or listing allowance, the
13 multiple listings are 30 cents for the first two listings, and 30 cents
14 for each additional listing (Gal Group 1).

15 *Gerszberg*

16 08. Gerszberg is directed to providing automated directory
17 assistance of telephone numbers over a local loop access
18 architecture (Gerszberg 1:6-8).

19 09. Gerszberg describes how a user initiates a directory assistance
20 transaction by pressing a soft-key on a vision phone/user interface,
21 and then verbally enters a directory assistance query. Gerszberg
22 then processes the natural language query, incorporates the street
23 address from which the directory assistance query was initiated,
24 searches the database, and prioritizes the search results. The
25 results are displayed on the video phone user interface as text
26 (Gerszberg 7:62-8:23).

1 10. Gerszberg describes how the user is provided with the option of
2 selecting a listing from the search results to be automatically
3 dialed (Gerszberg 8:30-32).

4 *Facts Related To Differences Between The Claimed Subject Matter And*
5 *The Prior Art*

6 11. None of the references applied describes selecting more than
7 one directory listing from a client access device and transmitting a
8 plurality of listing numbers to the client access device in response.

9 *Facts Related To The Level Of Skill In The Art*

10 12. Neither the Examiner nor the Appellants has addressed the level
11 of ordinary skill in the pertinent arts of systems analysis and
12 programming, telephone systems, directory assistance systems,
13 directory assistance billing systems, or user interface design. We
14 will therefore consider the cited prior art as representative of the
15 level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261
16 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific
17 findings on the level of skill in the art does not give rise to
18 reversible error ‘where the prior art itself reflects an appropriate
19 level and a need for testimony is not shown’”) (quoting *Litton*
20 *Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163
21 (Fed. Cir. 1985)).

1 *Facts Related To Secondary Considerations*

2 13. There is no evidence on record of secondary considerations of
3 non-obviousness for our consideration.

4

5 PRINCIPLES OF LAW

6 *Obviousness*

7 A claimed invention is unpatentable if the differences between it and
8 the prior art are “such that the subject matter as a whole would have been
9 obvious at the time the invention was made to a person having ordinary skill
10 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550
11 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

12 In *Graham*, the Court held that the obviousness analysis is bottomed
13 on several basic factual inquiries: “[1] the scope and content of the prior art
14 are to be determined; [(2)] differences between the prior art and the claims at
15 issue are to be ascertained; and [(3)] the level of ordinary skill in the
16 pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at 406.
17 “The combination of familiar elements according to known methods is likely
18 to be obvious when it does no more than yield predictable results.” *Id.* at
19 416.

20 “When a work is available in one field of endeavor, design incentives
21 and other market forces can prompt variations of it, either in the same field
22 or a different one. If a person of ordinary skill can implement a predictable
23 variation, § 103 likely bars its patentability.” *Id.* at 417.

24 “For the same reason, if a technique has been used to improve one
25 device, and a person of ordinary skill in the art would recognize that it would
26 improve similar devices in the same way, using the technique is obvious
27 unless its actual application is beyond his or her skill.” *Id.*

1 “Under the correct analysis, any need or problem known in the field
2 of endeavor at the time of invention and addressed by the patent can provide
3 a reason for combining the elements in the manner claimed.” *Id.* at 420.

4

ANALYSIS

6 *Claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 rejected under 35 U.S.C. §*
7 *103(a) as unpatentable over Cox, Gerszberg, and Gale Group.*

8 Claims 1, 9, 17, 25, and 33 are the only independent claims. Each of
9 these claims requires selecting more than one directory listing from a client
10 access device and transmitting a plurality of listing numbers to the client
11 access device in response.

12 The Examiner found that Cox described the directory assistance
13 process including display and billing, Gerszberg described displaying the
14 numbers, and Gale Group described multiple listings (Answer 4-5).

15 The Appellants contend that none of the references applied describes
16 selecting more than one directory listing from a client access device and
17 transmitting a plurality of listing numbers to the client access device in
18 response (Br. 13-15).

19 The Examiner responded

20 BOC "allows" customers to get more than the usual two
21 directory listings per call from the directory assistance. Two is
22 [a] multiple listing on top of allowing more than the initial two.
23 The examiner maintains that it is implied that if a user is
24 receiving two listings it is in response to some type of selection
25 by the user. The directory assistance would not send unwanted
26 to [sic.] listings to the user.

27 Answer 11. We disagree with the Examiner.

1 None of the references applied describes selecting more than one
2 directory listing from a client access device and transmitting a plurality of
3 listing numbers to the client access device in response (FF 11). The
4 Examiner has not found otherwise, but instead found that there must have
5 been some selection. While we agree there must have been some selection
6 to receive the two listings, this is far from implying that such a selection was
7 from among other directory listings from the client access device, instead of
8 from asking for names from the operator. The Examiner's rationale is that
9 in Gale Group, “[t]wo is [a] multiple listing on top of allowing more than the
10 initial two.” *Id.* It is unclear how the Examiner relies on this. If the
11 Examiner means to imply that the additional listings are selected from the
12 first set of listings, nothing in Gale Group states or implies this. Instead,
13 Gale Group simply describes increasing the number of entries that can be
14 retrieved to be more than two.

15 Each of the references states that selections of multiple numbers are
16 based on queries; the selection from among multiple numbers is of a single
17 entry rather than multiple entries. Cox describes conventional directory
18 assistance with a provision allowing the caller to recontact the operator (FF
19 01-04). Gerszberg describes displaying multiple numbers, but selecting one
20 from those numbers (FF 10). Gale Group describes customers getting
21 multiple listings, but again selecting only one (FF 06-07).

22 Thus, we conclude the Examiner has failed to present a *prima facie*
23 case. Since this issue is determinative, we need not reach the remaining
24 Appellants' arguments.

Claims 2-4, 10-12, 18-20, 26-28, and 34-36 rejected under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, Shah, and Gale Group.

3 These claims depend from the independent claims in the prior
4 rejection and therefore incorporate the same limitations. Nothing in Shah
5 overcomes the omissions in the Examiner's findings as to the independent
6 claims. Thus, the Examiner has failed to present a *prima facie* case as to this
7 rejection.

8

CONCLUSIONS OF LAW

10 The Appellants have sustained their burden of showing that the
11 Examiner erred in rejecting claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40
12 under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, and Gale
13 Group.

14 The Appellants have sustained their burden of showing that the
15 Examiner erred in rejecting claims 2-4, 10-12, 18-20, 26-28, and 34-36
16 under 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, Shah, and
17 Gale Group.

18

DECISION

20 To summarize, our decision is as follows:

21 • The rejection of claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 under
22 35 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, and Gale
23 Group is not sustained.

24 • The rejection of claims 2-4, 10-12, 18-20, 26-28, and 34-36 under 35
25 U.S.C. § 103(a) as unpatentable over Cox, Gerszberg, Shah, and Gale
26 Group is not sustained.

Appeal 2009-007311
Application 09/836,589

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REVERSED

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